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OFFICE OF PETITIONS

In re Application of	:	
O'Gorman et al.	:	DECISION ON APPLICATION
Application No. 08/919,501	:	FOR
Filed: August 28, 1997	:	PATENT TERM ADJUSTMENT
Attorney Docket No.	:	
SALK2190 (088802/5001)	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705," filed June 7, 2006. Applicants request that the initial determination under 35 USC 154(b) be corrected from seven hundred sixty-nine (769) days to one thousand three hundred ninety-eight (1398) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one thousand three hundred ninety-eight (1398) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On March 16, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application[1]. The Notice stated that the patent term adjustment

[1] By virtue of the filing of a continued prosecution application (CPA) filed under 37 CFR 1.53(d) on September 29, 2000, the application became entitled to the benefits of the patent term adjustment provisions of 35 U.S.C. 154(b) and 37 CFR 1.702 through 1.705.

(PTA) to date is 769 days. On June 7, 2006, applicants timely[2] submitted an application for patent term adjustment (with required fee). Applicants assert that an additional period of adjustment of 629 days should be credited due to inaction by the Office from June 25, 2004 (4 months after the February 25, 2004 BPAI decision in which the Examiner was reversed) until the mailing of the Notice of Allowance (on March 16, 2006).

Applicants state that the patent is not subject to a terminal disclaimer.

37 CFR 1.702(a)(3) provides that the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

> Act on an application not later than four months after the date of a decision by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or 135 or a decision by a Federal court under 35 U.S.C. 141, 145, or 146 where at least one allowable claim remains in the application;

37 CFR 1.703(a)(5) provides that:

> The number of days, if any, in the period beginning on the day after the date that is four months after the date of a final decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145 or 146 where at least one allowable claim remains in the application and ending on the date of mailing of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

As stated in the Final Rule[3] and in pertinent part in MPEP 2731,

> For a Board of Patent Appeals and Interferences decision to be a "decision by the Board of Patent Appeals and Interferences under [35 U.S.C.] 134" within the meaning of 35 U.S.C. 154(b)(1)(A)(iii) (and 1.703(a)(5)), the decision

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[2] PALM records indicate that the Issue Fee payment was also received on June 7, 2006.

[3] See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000).

must sustain or reverse the rejection(s) of the claim(s) on appeal. For a Board of Patent Appeals and Interferences decision to be a "decision by the Board of Patent Appeals and Interferences under [35 U.S.C.] 135" within the meaning of 35 U.S.C. 154(b)(1)(A)(iii) (and 1.703(a)(5)), the decision must include a decision on the patentability of the claims or priority of invention. A remand or other administrative order by the Board of Patent Appeals and Interferences (even if by a merits panel) is not a "decision" within the meaning of 35 U.S.C. 154(b)(1)(A)(iii)(and 1.703(a)(5)).

The phrase "final decision" in 1.703(a)(5) means that: (1) the decision is the last decision in the review by the Board of Patent Appeals and Interferences (or by a Federal court); and (2) the decision does not require further action by the applicant to avoid termination of proceedings as to the rejected claims. Thus, a Board of Patent Appeals and Interferences decision containing a new ground of rejection under 1.196(b) requires action by the applicant to avoid termination of proceedings as to the rejected claims and is thus not considered a "final decision" for purposes of 1.703(a)(5). The phrase "final decision," however, does not require that the decision be final for purposes of judicial review (e.g., a Board of Patent Appeals and Interferences decision reversing the rejection of all of the claims on appeal is not "final" for purposes of judicial review, but (absent a subsequent decision by the Board of Patent Appeals and Interferences) is a "final decision" for purposes of 1.703(a)(5)).

The phrase "allowable claims remain in the application" for purposes of 35 U.S.C. 154(b)(1)(A)(iii) means that after the decision there is at least one pending claim (for purposes of statutory construction, "words importing the plural include the singular" (1 U.S.C. 1)) that is not withdrawn from consideration and is not subject to a rejection, objection, or other requirement. This applies in the following situations: (1) at least one claim is allowable (not merely objected to) at the time the examiner's answer is mailed and is not canceled before, or made subject to a rejection as a result of, the appellate review; or (2) when all of the rejections applied to at least one claim are reversed, and such claim is not

made subject to a rejection, as a result of the appellate review. For example:

(1) If claims 1 and 2 (both independent) are pending, the decision affirms the rejection of claim 1, and claim 2 was indicated as allowable prior to the appeal, "allowable claims remain in the application" for purposes of 35 U.S.C. 154(b)(1)(A)(iii).

(2) If claims 1 and 2 are pending, the decision affirms the rejection of claim 1, and claim 2 was objected to by the examiner prior to the appeal as being allowable except for its dependency from claim 1, "allowable claims" do not "remain in the application" for purposes of 35 U.S.C. 154(b)(1)(A)(iii) (claim 2 is not allowable because there is an outstanding objection to it).

(3) If claims 1 and 2 are pending, the decision affirms the rejection of claim 1 and reverses the rejection of claim 2, "allowable claims remain in the application" for purposes of 35 U.S.C. 154(b)(1)(A)(iii)(claim 2 is "allowable" within the meaning of 1.703(a)(5) because there is no outstanding objection or requirement as to it until the examiner issues a notice under section 1214.06, paragraph (I)(B) of the Manual of Patent Examining Procedure (7th ed.1998) (Rev. 1, Feb. 2000)(MPEP)).

A review of the record confirms that such a final decision by the BPAI was issued on February 25, 2004 and that allowable claims remained in the application, and that the Office did not respond with the mailing of a notice of allowance until March 16, 2006, four months and 629 days later. Thus, applicants are correct that entry of an additional period of adjustment of 629 days pursuant to §§ 1.702(a)(3) and 1.703(a)(5) is warranted.

It is noted that the courtesy copy of the Appeal Brief was entered in the image file wrapper with its date of receipt, July 13, 2004. There is no indication in the record that this affected calculation of the patent term adjustment (or that this was improper for a courtesy copy). As can be seen in the copy of revised PALM screen enclosed with this decision, there is properly no such entry in the PTA calculations for the courtesy copy.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is one thousand three hundred ninety-eight (1398) days.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. Any further period of adjustment accrued pursuant to 37 CFR 1.702(a)(4) and 1.702(b) will be reflected in the patent term adjustment shown on the issue notification letter mailed approximately three weeks prior to the issuance of the patent.

Applicants are reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004).

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised PALM Screen

PTA Calculations for Application: 08/919501			
Application Filing Date:	08/28/1997	PTO Delay (PTO):	864
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	95
Post-Issue Petitions:	0	Total PTA (days):	1398
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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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